

REMARKS

This application has been carefully reviewed in light of the Office Action mailed June 10, 2004. Claims 1-37 are pending in the application and stand rejected. Applicant respectfully requests reconsideration and favorable action of all pending claims in view of the following remarks.

Section 102 and 103 Rejections

Claims 1-2, 4-10, 12-15, 17-22, 24-28, and 30-37 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 2002/0179720 issued to *Liva* ("*Liva*"), and Claims 3, 11, 16, 23, and 29 35 under U.S.C. 103(a) as being unpatentable over *Liva*, further in view of by U.S. Patent No. 2002/0112940 issued to Heilmann ("*Heilmann*"). Applicant respectfully traverses.

In the previous Response to Office Action filed March 31, 2004, Applicant argued that (1) *Liva* did not teach the claim limitations of the independent claims and (2) *Liva* was not prior art against the present application because its actual filing date was after the filing date of the present application and the provisional application from which it claimed priority failed to provide support for the claim limitations. In response, the present Office Action now argues that (1) the provisional application from which *Liva* claims priority discloses the claim limitations of the independent claims and that (2) "[a]s Applicant raises the issue of inadequate disclosure in the provisional Application, Examiner has based his response on disclosure from the provisional Application; the parallels to the publication relied upon and cited in the rejection maintained above are clear."

Applicant contends that the above rejections are improper because (1) *Liva* does not show the claim limitations argued in Applicant's previous response and the Office Action has improperly relied on the provisional application from which *Liva* claims priority to try to show the claim limitations rather than showing them in *Liva* itself (in addition to establishing that *Liva* is entitled to the earlier priority date with respect to those claim limitations) and (2) in any event, the provisional application does not actually disclose what the Office Action contends it discloses.

The provisional application from which *Liva* claims priority is not prior art under any section of 35 U.S.C. Section 102. Rather, this provisional is only pertinent as a priority document to the extent the PTO seeks to reject the present Application in view of the

disclosure of *Liva*, because *Liva* does not predate the present Application. Thus, any rejection based on *Liva* must be (1) based on the disclosure of *Liva* and (2) further include a showing of support in the provisional to which *Liva* claims priority. A rejection based solely on the provisional application would clearly be improper because that application does not qualify as prior art under 35. U.S.C. Section 102, as would a rejection based on any portion of *Liva* that was not also supported in the provisional application.

Claim 1 is allowable at least because the "coupling the input node of the first card to the input node of the second card to provide redundancy for the first card by connecting the input node of the first card to the associated output node of the first card" limitation is not shown in *Liva* and because the Office Action fails to identify any portion of *Liva* showing this limitation.

Liva does not show the above-recited limitation for the reasons described in Applicant's previous Response. In particular, the systems of Figures 4 and 5, on which the Office Action relies, involve decoupling input and output nodes of line cards from respective connections and coupling of these nodes to other connections – but not to each other. The Office Action's only response to these arguments occurs in the "Response to Arguments" section of the current Office Action, in which it states that the provisional application from which *Liva* claims priority discloses this limitation. Although this is incorrect as described below, the above claim limitation is not disclosed in *Liva* itself, and the Office Action fails to identify such a limitation in *Liva*, which would be required for a rejection.¹ In addition, the present Office Action continues to reject Claim 1 by asserting that *Liva* shows "connecting the input node of the first card, thereby coupling the input node of the first card to the input node of the second card to provide redundancy" rather than addressing the actual claim language of "connecting the input node of the **first card to the associated output node of the first card.**" Thus, to date, no Office Action has even asserted that all of the claim limitations of Claim 1 have been met by *Liva*, let alone identified them in *Liva*.

For at least these reasons Claim 1 is allowable, as are the claims depending therefrom. Reconsideration and favorable action are requested.

¹ The Office Action states "[e]xaminer has based the response on disclosure from the provisional Application; the parallels to the publication relied upon and cited in the rejection maintained above are clear," but this is incorrect. The parallels are not clear. Rather, the disclosure of *Liva* and the provisional application differ. Figures 4 and 5 of *Liva*, on which the Office Actions rely differ significantly from the Appendix of the provisional application.

In addition, the provisional application also fails to disclose "coupling the input node of the first card to the input node of the second card to provide redundancy for the first card by connecting the input node of the first card to the associated output node of the first card" and for this additional reason the rejection is improper, because *Liva* does not predate the present Application.

In asserting that the provisional application teaches this limitation the Office Action refers primarily to the third figure in the Appendix, but Applicant believes the PTO misunderstood the labeling of the boxes in that figure. In particular, the circuitry shown in the boxes labeled "Line Card #1" and "Line Card #2" do not correspond to circuitry on a line card for which redundancy is provided. Rather its circuitry on an I/O card that may be connected to line cards through the "Local RF Out" and "Local RF In" ports; and the provisional application clearly fails to show connecting the "Local RF Out" and "Local RF In" ports to each other to provide redundancy. This is confirmed on the first and second pages of the Appendix where it states "[a] number of these can be deployed on **the I/O card associated with a PBComm Line Card** as follows (one each downstream and upstream shown): "Local input or output refers to signals to/from the **associated Line Card**. 'B/U' refers to a set of buses used for the backup function. 'RF In' and 'RF Out' refer to the rear panel connectors providing connections to/from the cable plant." **Thus, the labels "Line Card #1" and "Line Card #2" do not refer to line cards having the given circuitry, but rather that the illustrated circuitry may be connected to "Line Card #1" and "Line Card #2."** Thus, the provisional application does not show "coupling the input node of the first card to the input node of the second card to provide redundancy for the first card by connecting the input node of the first card to the associated output node of the first card." For at least this additional reason, Claim 1 is allowable. Reconsideration and favorable action is requested.

The remaining independent Claims 14, 26, and 35 are allowable for analogous reasons. As depending for an allowable independent claim, all pending dependent claims are also allowable. Reconsideration and favorable action are requested.

Claims 35 through 37 are also allowable because the Office Action has failed to make a *prima facie* showing of equivalence between the asserted element and the "means for selectively connecting" and the "means for connecting" claimed in Claim 35, as required by the Manual of Patent Examining Procedure. See M.P.E.P. Section 2183. That provision requires the PTO to "provide an explanation and a rationale in the Office Action as to why

the [asserted prior art element] is an equivalent [of the corresponding element in the specification.]" In other words, the PTO cannot rely on simply asserting that the claimed function of a means plus function limitation is met, but must also establish a *prima facie* case of equivalence regarding the corresponding structure. The present Office Action is completely silent in this regard, stating merely that "[r]egarding Claim 35, *Liva* discloses first and second cards and means for selectively connecting the input node of the first card to the output node of the first card and means for connecting the output node of the first card to the input node of the second card (e.g., Figure 5)." This is clearly not "an explanation and rationale in the Office Action as to why the prior art element is an equivalent" required by M.P.E.P. Section 2183. Rather, it appears the common PTO practice before *In re Donaldson* of rejecting means plus function claims without reference to determining whether the corresponding means are equivalent is being improperly applied here. As failing to comply with the requirements of the M.P.E.P, the rejection of Claims 35-37 is improper for this additional reason. Reconsideration and favorable action are requested.

CONCLUSION

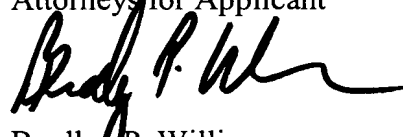
Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other apparent reasons, Applicant respectfully requests allowance of all pending claims.

If the Examiner feels that prosecution of the present Application may be advanced in any way by a telephone conference, the Examiner is invited to contact the undersigned attorney at 214-953-6447.

Applicant does not believe that any fees are due. However, the Commissioner is hereby authorized to charge these fees and any extra fee or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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